

## **REMARKS**

The present amendment is submitted in response to an Office Action dated September 24, 2002. Claims 1-9, 11, 12, 14-25, 27-33, 36-41, 43-49, 52-57, 59-65, 68-73 and 75-98 stand rejected under 35 U.S.C. §112, first paragraph, as not being enabling. Claims 2-3, 7, 18-19, 23, 39, 55, 71, 83-84 and 91 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claims 1, 6-10, 17, 22-26, 33, 38-42, 49, 54-58, 65, 70-74, 81, 82, 87-91 and 98 stand rejected under 35 U.S.C. §102(b) as being anticipated by Wilpers et al. Claims 2-5, 11-15, 18-21, 27-31, 34-37, 43-47, 50-53, 59-63, 66-69, 75-79, 83-86 and 92-96 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Wilpers et al. Claims 1-98 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 10, 12-18, 24, 27-30, 42 and 44-81 of copending Application No. <sup>09</sup>/293,401 and claims 1-20 of copending Application No. <sup>09</sup>/539,529.

New claims 99-126 have been submitted for examination. Applicants respectfully submit that the newly added claims are novel and non-obvious over any of the art cited, taken singly or in combination. New claims 99-126 are clearly supported by the specification and add no new matter.

### **I. REJECTIONS UNDER 35 U.S.C. §112**

Claims 1-9, 11, 12, 14-25, 27-33, 36-41, 43-49, 52-57, 59-65, 68-73 and 75-98 stand rejected under 35 U.S.C. §112, first paragraph, as containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicants respectfully submit that the specification enables the scope of the pending claims and that the rejection fails to recite prima facie grounds for this rejection..

Initially, Applicants respectfully assert that the outstanding office action fails to present a prima facie case of non-enablement for the term "adhesive" as recited in the claims. Section 2164.02 of the MPEP requires that when a non-enablement rejection is based, as here, on the use of a single example in the specification while reciting claim language broader than that one example:

a valid rejection... [must] state why one would not expect to be able to extrapolate that one example across the entire scope of the claims. (Emphasis added)

This the outstanding rejection does not do. For the reasons set forth below, Applicants respectfully assert that proper reasoning to support such a statement does not exist.

The term "adhesive" is, as used in the present application, sufficiently enabled by the specification, and persons having ordinary skill in the art would understand that the term "adhesive" is not limited to maleic anhydride. Rather, the "adhesive" can include any adhesive known by persons having ordinary skill in the art to facilitate bonding of the layers of the claimed containers as described in the specification and defined in the claims.

The standard for determining whether the specification is enabling was cast long ago by the Supreme Court in Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916), which held that an invention is not enabled if undue or unreasonable experimentation is necessary to practice the invention based on the teachings of the specification. The Federal Circuit has adopted this standard (See, e.g., In re Wands, 852 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)) and has set forth a number of factors that must be considered when determining whether a disclosure satisfies the enablement requirement. These factors include, but are not limited to:

- a) The breadth of the claims;
- b) The nature of the invention;
- c) The state of the prior art;

- d) The level of one of ordinary skill;
- e) The level of predictability in the art;
- f) The amount of direction provided by the inventor;
- g) The existence of working examples; and
- h) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

See id. The MPEP concurs stating that:

It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The Examiner's analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole.

MPEP §2164.01(a) (citing In re Wands, 858 F.2d at 740, 8 USPQ2d at 1407).

The Office Action states that the disclosure is not enabling for the general term "adhesive" because the Applicants disclose only maleic anhydride as an example. In essence, this position concludes that the disclosure is not enabling because the specification provides only one working example of an adhesive. Applicants respectfully point out that the MPEP has specifically cautioned against enablement rejections based on this reasoning:

The presence of only one working example should never be the sole reason for rejecting claims as being broader than the enabling disclosure, even though it is a factor to be considered along with other factors.

MPEP §2164.02. While the specification only discloses one working example of the adhesive expressly (i.e., maleic anhydride), Applicants assert that a person of ordinary skill in the art would have understood the term "adhesive" to encompass adhesives other than maleic anhydride and that "undue or unreasonable experimentation" would not be required to practice the invention with other adhesives. As the Examiner has recognized, the specification generally discloses the end sought to be achieved through use of the "adhesive" stating that "an appropriate adhesive is chosen dependent upon the material of the middle layer 26 to bond the inner and outer layers 24, 28 thereto." (See Specification P. 8, first

paragraph). Certainly, one of ordinary skill in the art would be lead by this statement to understand that the term "adhesive" includes adhesives other than maleic anhydride.

Nowhere does the specification limit the term "adhesive" to maleic anhydride. To the contrary, the specification impliedly defines the term "adhesive" broader than maleic anhydride by employing the general term "adhesive" at least forty-two (42) times throughout the specification without limiting its definition. Not until describing the working embodiments does the specification identify maleic anhydride as an example. (See, First Embodiment, Examples 1-10). The distinctive use of the term "adhesive" and the example of maleic anhydride would clearly lead one of ordinary skill in the art to understand that the maleic anhydride is only one example of the "adhesive" described in the specification for bonding the inner and/or outer layers to the middle barrier layer without the need of separate adhesive layers, and that the term "adhesive" should not be restricted or otherwise limited to maleic anhydride set forth in the examples. Indeed, the term "maleic anhydride" is used under the heading of "Example." Thus, one of ordinary skill in the art would recognize that other adhesives, especially those having polar groups, would bind the relatively non-polar first layer of polypropylene to the relatively polar second layer of barrier material. Applicants were free to use the term "maleic anhydride" rather than "adhesive" throughout the specification -- but did not.

The fact that other specific adhesives are not disclosed in the specification is not fatal to the use of the broad term "adhesive" in the claims. The Federal Circuit has stated that, "[a] patent need not teach, and preferably omits, what is well-known in the art." In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1986); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1382, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480

U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Applicants respectfully submit, therefore, that the disclosure is enabling for the general term "adhesive" as used throughout the claims of the present invention. Persons having ordinary skill in the art can make and use the claimed invention without "undue or unreasonable experimentation" because persons having ordinary skill in the art would recognize other adhesives for binding the first layer to the barrier layer besides maleic anhydride.

With respect to the rejection of claims 83, 84 and 91 under 35 U.S.C. §112, second paragraph, as being indefinite, Applicants respectfully submit that claim 82 has been amended to define that the first layer comprises an adhesive. Applicants respectfully submit that the amendment renders the claims definite, in that there is now antecedent basis for the term "adhesive" in claims 83, 84 and 91.

With respect to the rejection of claim 7, 23, 39, 55 and 71 under 35 U.S.C. §112, second paragraph, Applicants respectfully submit that the amendments to the claims overcome this rejection. More specifically, Applicants have amended the claims to remove the term "MXD6" from the claims.

With respect to the rejection of claims 2-3 and 18-19 under 35 U.S.C. §112, second paragraph, Applicants submit that the amendments to the claims now render the claims definite. It is apparent that the adhesive recited in claims 1 and 17 comprises, among others, the maleic anhydride referred to in claims 2,3 and 18, 19, respectively.

## **II. REJECTIONS UNDER 35 U.S.C. §§ 102(b) and 103(a)**

The claims stand rejected under either 35 U.S.C. §102(b) or 35 U.S.C. §103(a) as being anticipated or unpatentable over SIR H1419 to Wilpers et al. (Wilpers et al.).

Applicants respectfully submit that the amendments to independent claims 1, 17, 33, 49, 65 and 82 overcome these rejections. The independent claims now define that the container is stretch blow molded and biaxially stretched. Moreover, each independent claim now defines that each container has a haze value of less than approximately 29% measured through a section of the container having a total thickness of greater than approximately 15 mils. These features are nowhere taught or even contemplated by Wilpers et al. Although Wilpers et al. teach that various articles may be made using the film of Wilpers et al., Wilpers et al. fail to teach stretch blow molded containers as claimed. Wilpers et al. also fail to teach the haze values as defined in the amended claims. In addition, Wilpers et al. fail to teach a container having a first layer of polypropylene and a second layer of oxygen barrier material wherein the first layer is either an innermost or outermost layer of the container and further wherein maleic anhydride modified polypropylene is incorporated into the first or second layers to facilitate bonding between the first and second layers.

Additionally, Applicants assert that the haze values recited in the claims are not inherent from the structures as stated by the Examiner. Rather, the haze can vary dramatically based on heat and timing of processing, rate of cooling and the amount and type of stretching imparted to the structure created from the materials as well as the temperature of the structure during stretching. One of ordinary skill in the art readily understands that the structure itself does not dictate the haze value.

Claims 2-3, 5-9, 11-12, and 14-16 depend from independent claim 1; claims 18-19, 23-25, 27-28, and 30-32 depend from independent claim 17; claims 34-35, 37-41, 43-44, and 46-48 depend from independent claim 33; claims 50-51, 53-57, 59-60, and 62-64 depend from independent claim 49; claims 66-67, 69-73, 75-76, and 78-81 depend from independent

Serial No. <sup>09</sup>/901,427

claim 65; and claims 83-84, 86-90, 92-93, and 95-98 depend from independent claim 82. These claims are believed to be allowable over the reference of record for the same reasons set forth above with respect to their respective parent claims and, additionally, for the novel elements set forth in each.

### **III. PROVISIONAL OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTION**

Claims 1-98 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 10, 12-18, 24, 27-30, 42 and 44-81 of copending U.S. Patent Application Serial No. <sup>09</sup>/293,401. In addition, claims 1-98 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-20 of copending U.S. Patent Application Serial No. <sup>09</sup>/539,529. Applicants state that they will submit terminal disclaimers to overcome these provisional rejections when all other rejections have been overcome and the application is otherwise in condition for allowance. Applicants' offer to submit a terminal disclaimer shall not be construed as an admission that Applicants agree that the pending claims are obvious over any of the claims of U.S. Patent Application Serial Nos. <sup>09</sup>/293,401 and <sup>09</sup>/539,529.

### **CONCLUSION**

In view of the foregoing, Applicants respectfully request that the Examiner indicate all claims as allowable. If, however, any outstanding issues remain, Applicants urge the Examiner to telephone Applicants' attorney at 312-372-2000 so that the same may be resolved expeditiously. No new matter has been introduced to the present application by this amendment.

Serial No. <sup>09</sup>/901,427

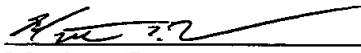
Attached hereto is a marked-up version of the changes made to the claims by this paper. The attached page is captioned "Version With Markings To Show Changes."

Respectfully submitted,

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**Version with Markings to Show Changes**

IN THE CLAIMS:

Please cancel claims 4, 20, 36, 52, 68, and 85 without prejudice.

Please amend the claims as follows:

1. (Amended) A stretch blow molded multilayer container comprising:  
a first layer defining an outermost layer of the container and comprising polypropylene; and  
a second layer comprising an oxygen barrier material, directly adjacent to said first layer;  
at least one of said first and second [layer] layers further comprises an adhesive mixed therein to facilitate bonding between the first and second layers, the container having been biaxially stretched and having a haze value of less than approximately 29% measured through a section of the container having a total thickness of greater than approximately 15 mils.
2. (Amended) The container of claim 1 the first layer comprising the adhesive wherein said adhesive comprises approximately 0.01% to 0.20% maleic anhydride.
3. (Amended) The container of claim 1 the first layer comprising the adhesive wherein said adhesive comprises approximately 0.015% maleic anhydride.
7. (Amended) The container of claim 1 wherein said second layer comprises [MXD6] nylon.
17. (Amended) A stretch blow molded multilayer container comprising:  
a first layer defining an innermost layer of the container and comprising polypropylene; and

a second layer comprising an oxygen barrier material, directly adjacent to said first layer;

at least one of the first and second [layer] layers further comprising an adhesive mixed therein to facilitate bonding between the first and second layers, the container having been biaxially stretched and having a haze value of less than approximately 29% measured through a section of the container having a total thickness of greater than approximately 15 mils.

18. (Amended) The container of claim 17 the first layer comprising the adhesive wherein said adhesive comprises approximately 0.01% to about 0.20% maleic anhydride.

19. (Amended) The container of claim 17 the first layer comprising the adhesive wherein said adhesive comprises approximately 0.015% maleic anhydride.

23. (Amended) The container of claim 17 wherein said second layer comprises [MXD6] nylon.

33. (Amended) A stretch blow molded multilayer container comprising:

a first layer defining an outermost layer of the container and comprising a blend of a polypropylene and an adhesive; and

a second layer comprising an oxygen barrier material, directly adjacent to said first layer;

the adhesive facilitating bonding between the first layer and the second layer, the container having been biaxially stretched and having a haze value of less than approximately 29% when measured through a section of the container having a total thickness of greater than approximately 15 mils.

39. (Amended) The container of claim 33 wherein said second layer comprises

[MXD6] nylon.

49. (Amended) A stretch blow molded multilayer container comprising:

a first layer defining an innermost layer of the container and comprising a blend of a polypropylene and an adhesive; and

a second layer comprising an oxygen barrier material, directly adjacent to said first layer;

the adhesive facilitating bonding between the first layer and the second layer, the container having been biaxially stretched and having a haze value of less than approximately 29% when measured through a section of the container having a total thickness of greater than approximately 15 mils.

55. (Amended) The container of claim 33 wherein said second layer comprises [MXD6] nylon.

65. (Amended) A stretch blow molded multilayer container comprising:

a first layer comprising a blend of a polypropylene and an adhesive; and

a second layer comprising an oxygen barrier material, directly adjacent to said first layer;

the adhesive facilitating bonding between the first layer and the second layer, the first layer not having [a] an adhesive-free layer [comprised of polypropylene free of adhesive] directly adjacent thereto other than the first layer, the container having been biaxially stretched and having a haze value of less than approximately 29% when measured through a section of the container having a total thickness of greater than approximately 15 mils.

71. (Amended) The container of claim 65 wherein said second layer comprises [MXD6] nylon.

82. (Amended) A stretch blow molded multilayer container comprising:  
a first layer comprising polypropylene and an adhesive; and  
a second layer comprising an oxygen barrier material;  
the container having been biaxially stretched and the container having a haze value  
of less than approximately 29% measured through a section of the container having a total  
thickness of greater than approximately 15 mils.

88. (Amended) The container of claim 82 wherein said second layer comprises [MXD6] nylon.